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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,163	01/24/2004	Amanda K. Bridges	2003-0667.02	8163
21972 7590 07/03/2008 LEXMARK INTERNATIONAL, INC. INTELLECTUAL PROPERTY LAW DEPARTMENT 740 WEST NEW CIRCLE ROAD BLDG. 082-1 LEXINGTON, KY 40550-0999				
EXAMINER				
CHEEMA, UMAR				
ART UNIT		PAPER NUMBER		
2144				
MAIL DATE		DELIVERY MODE		
07/03/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/764,163

**Applicant(s)**

BRIDGES ET AL.

**Examiner**

UMAR CHEEMA

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3-7, 9-27, 29-31, 34 and 35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-7, 9-27, 29-31, 34 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 04/03/2008
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is response to the Amendment filed on 3 April 2008. Claims 1, 3-7, 9-27, 34 and 35 are pending with claims 1, 3, 9, and 24 been amended. Claims 2, 8, 32, 33 have been canceled. New claims 34 and 35 have been added.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 04/03/2008 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1, 3-7, 9-27, 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsushima (US Patent # 7,019,860) in view of Bahar (US 2002/0019852).

Regarding claim 1, Matsushima substantially discloses the invention as claimed a method of using a print device, comprising the steps of: carrying out a specified task at a print device (see col. 1, lines 61-67, col. 2, lines 1-2, printer engine); determining by the printer device, whether the specified task was carried out successfully by the printer device (see col. 1, lines 60-67-col. 2, lines 1-26; image information); and generating an email confirmation, automatically by the print device, including an indication of success or failure of said carried out task at said print device (see col. 7, lines 26-34, col. 8, lines 46-54, Fig 11 to Fig 13); wherein said step of carrying out a specified task includes rendering image data at said print device (see col. 1, lines 60-67-col. 2, lines 1-26; image information); and wherein said email confirmation includes a thumbnail image associated with said rendered image data upon a successful rendering of said image data, and said email confirmation does not include a thumbnail image associated with said rendered image data upon an unsuccessful rendering of said image data (see col. 7, lines 26-34, col. 8, lines 46-54, Fig 11 to Fig 13 lines 50-57).

Matsushima does not explicitly disclose wherein said generating an email confirmation. However in the same field of invention Bahar discloses wherein said generating an email confirmation (see par. 0013, 0034, 0038; providing notice of the email and generating the confirmation of receipt notice).

It would have been obvious to one of the ordinary skill in the art of networking at the time of this invention to combine the teaching of Matsushima and Bahar for email confirmation for specific task at print device. Motivation for doing so would have been advantageous to actively determine the identity of the recipient individual actually receiving and/or given notice of the email, as well as other actively discovered information indicative of proper delivery which is found on the recipient computer system of the recipient individual (see Bahar: par. 0008).

Regarding claim 2 (Canceled).

Regarding claim 3, Matsushima discloses the method of claim 1, wherein said rendered image data corresponds to one of a scan to network job and a fax job (see col. 10, lines 51-56).

Regarding claim 4, Matsushima discloses the method of claim 1, wherein said email confirmation relates to a scan to network job (see col. 10, lines 42-48).

Regarding claim 5, Matsushima discloses the method of claim 4, wherein said email confirmation includes upon said failure at least one of a primary SMTP gateway IP address (see col. 1, lines 27-33); a connection failure, and number of connection tries; and a mail server response (see col. 7, lines 26-34, col. 11, lines 8-23).

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Regarding claim 6, Matsushima discloses the method of claim 1, wherein said email confirmation relates to a fax job (see col. 10, lines 51-56).

Regarding claim 7, Matsushima discloses the method of claim 6, wherein said email confirmation includes upon said failure at least one of a connection failure, and number of connection tries; date; station name; and station number (see col. 7, lines 13-19).

Regarding claim 8 (Canceled).

Regarding claim 9, Matsushima discloses the method of claim 1, wherein said email confirmation includes an attachment (see col. 7, lines 50-57).

Regarding claim 10, Matsushima discloses the method of claim 9, wherein said email confirmation includes a thumbnail image of said attachment (see col. 7, lines 50-57).

Regarding claim 11, Matsushima discloses the method of claim 9, wherein said email confirmation includes a thumbnail image of said attachment upon a successful rendering of said image data, and said email confirmation does not include a thumbnail image of said attachment upon an unsuccessful rendering of said image data (see col. 7, lines 26-34, col. 8, lines 46-54, Fig 11 to Fig 13 lines 50-57).

Regarding claim 12, Matsushima discloses the method of claim 9, wherein said email

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confirmation comprises information relating to said attachment, including at least one of a file name, data format, and rendered image resolution (see col. 7, lines 26-34).

Regarding claim 13, Matsushima discloses the method of claim 1, wherein said generating step includes the substep of transmitting said email confirmation over a network (see col. 4, lines 57-63).

Regarding claim 14, Matsushima discloses the method of claim 13, wherein said transmitting step includes transmitting said email confirmation over a network using one of said print device and a computer attached to said network (see col. 7, lines 13-19, lines 50-57).

Regarding claim 15, Matsushima discloses the method of claim 1, wherein said print device is part of a multi-function machine (see col. 3, lines 35-40, fig. 1).

Regarding claim 16, Matsushima substantially discloses the invention as claimed a method of using a print device, comprising the steps of: carrying out a specified task at a print device (see col. 1, lines 61-67, col. 2, lines 1-2, printer engine); and generating an email confirmation including an indication of success or failure of said carried out task at said print device, said email confirmation including a thumbnail image associated with said specified task upon successfully carrying out said specified task, and said email confirmation not including a thumbnail image associated with said specified task

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upon unsuccessfully carrying out said specified task (see col. 7, lines 26-34, col. 8, lines 46-54, Fig 11 to Fig 13).

Matsushima does not explicitly disclose wherein said generating an email confirmation. However in the same field of invention Bahar discloses wherein said generating an email confirmation (see par. 0013, 0034, 0038; providing notice of the email and generating the confirmation of receipt notice).

It would have been obvious to one of the ordinary skill in the art of networking at the time of this invention to combine the teaching of Matsushima and Bahar for email confirmation for specific task at print device. Motivation for doing so would have been advantageous to actively determine the identity of the recipient individual actually receiving and/or given notice of the email, as well as other actively discovered information indicative of proper delivery which is found on the recipient computer system of the recipient individual (see Bahar: par. 0008).

Regarding claim 17, the limitations of this claim has already been addressed (see claim 2 above).

Regarding claim 18, the limitations of this claim has already been addressed (see claim 3 above).

Regarding claim 19, the limitations of this claim has already been addressed (see claim 8 above).



Regarding claim 20, the limitations of this claim has already been addressed (see claim 9 above).

Regarding claim 21, the limitations of this claim has already been addressed (see claim 13 above).

Regarding claim 22, the limitations of this claim has already been addressed (see claim 14 above).

Regarding claim 23, the limitations of this claim has already been addressed (see claim 15 above).

Regarding claim 24, Matsushima substantially discloses the invention as claimed a method of using a print device, comprising the steps of: carrying out a Specified task at a print device (see col. 1, lines 61-67, col. 2, lines 1-2, printer engine); determining, by the print device, whether the specified task was carried out successfully by the print device (see col. 1, lines 60-67-col. 2, lines 1-26; image information); and generating an email confirmation by said print device, said email confirmation including information pertaining to said specified task (see col. 7, lines 26-34, col. 8, lines 46-54, Fig 11 to Fig 13); wherein said email confirmation includes a thumbnail image associated with the specified task (see col. 7, lines 26-34, col. 8, lines 46-54, Fig 11 to Fig 13 lines 50-57).

Matsushima does not explicitly disclose wherein said generating an email confirmation. However in the same field of invention Bahar discloses wherein said generating an email confirmation (see par. 0013, 0034, 0038; providing notice of the email and generating the confirmation of receipt notice).

It would have been obvious to one of the ordinary skill in the art of networking at the time of this invention to combine the teaching of Matsushima and Bahar for email confirmation for specific task at print device. Motivation for doing so would have been advantageous to actively determine the identity of the recipient individual actually receiving and/or given notice of the email, as well as other actively discovered information indicative of proper delivery which is found on the recipient computer system of the recipient individual (see Bahar: par. 0008).

Regarding claim 25, the limitations of this claim has already been addressed (see claim 1 above).

Regarding claim 26, the limitations of this claim has already been addressed (see claim 2 above).

Regarding claim 27, the limitations of this claim has already been addressed (see claim 3 above).

Regarding claim 28 (Canceled).

Regarding claim 29, the limitations of this claim has already been addressed (see claim 13 above).

Regarding claim 30, the limitations of this claim has already been addressed (see claim 14 above).

Regarding claim 31, the limitations of this claim has already been addressed (see claim 15 above).

Regarding claims 32-33, (Canceled).

Regarding claim 34, Matsushima substantially discloses the invention as claimed a method of using a print device, comprising the steps of: carrying out a specified task at a print device (col. 1, lines 61-67, col. 2, lines 1-2, printer engine); determining, by the print device, whether the specified task was carried out successfully by the print device (see col. 1, lines 60-67-col. 2, lines 1-26; image information); and generating an email confirmation, automatically by the print device, including an indication of success or failure of said carried out task at said print device; wherein said email confirmation relates to a scan to network job (see col. 7, lines 26-34, col. 8, lines 46-54, Fig 11 to Fig 13; col. 10, lines 42-56).

Matsushima does not explicitly disclose wherein said generating an email confirmation. However in the same field of invention Bahar discloses wherein said generating an email confirmation (see par. 0013, 0034, 0038; providing notice of the email and generating the confirmation of receipt notice).

It would have been obvious to one of the ordinary skill in the art of networking at the time of this invention to combine the teaching of Matsushima and Bahar for email confirmation for specific task at print device. Motivation for doing so would have been advantageous to actively determine the identity of the recipient individual actually receiving and/or given notice of the email, as well as other actively discovered information indicative of proper delivery which is found on the recipient computer system of the recipient individual (see Bahar: par. 0008).

Regarding claim 35, Matsushima discloses the method of claim 34, wherein said email confirmation includes upon said failure at least one of a primary SMTP gateway IP address; a connection failure, and number of connection tries; and an email server response (see col. 1, lines 15-33, col. 7, lines 20-44, col. 11, lines 8-23).

### ***Response to Arguments***

4. Applicant's arguments filed on 03 April 2008 have been fully considered but they are not persuasive. However, because there exists the likelihood of future presentation of this argument, the Examiner thinks that it is prudent to address applicant's main point of contention. Applicant's arguments include:

A. Regarding to independent claims 1, 16, 24 and their dependent claims, Applicant argues that Matsushima in view of Bahar does not teach or suggest:

1. "determining, by the print device, whether the specified task was carried out successfully by the print device."
2. "generating an email confirmation, automatically by the print device, including an indication of success or failure of said carried out task at said print device."
3. "wherein said email confirmation includes a thumbnail image associated with said rendered image data upon a successful rendered of said image data, and said email confirmation does not include a thumbnail image associated with said rendered image data upon an unsuccessful rendering of said image data."

**As for Point A**, it is Examiner's position that Matsushima in view of Bahar teaches or suggests "determining, by the print device, whether the specified task was carried out successfully by the print device (see Matsushima: col. 1, lines 60-67-col. 2, lines 1-26; image information), generating an email confirmation, automatically by the print device, including an indication of success or failure of said carried out task at said print device (see Matsushima: col. 7, lines 26-34, col. 8, lines 46-54, Fig 11 to Fig 13; Bahar: see par. 0013, 0034, 0038, figures 1-5 and text related to the figures; providing notice of the email and generating the confirmation of receipt notice), wherein said email confirmation includes a thumbnail image associated with said rendered image data upon a successful rendered of said image data, and said email confirmation does not include a thumbnail image associated with said rendered image data upon an unsuccessful

rendering of said image data (see Matsushima: col. 7, lines 26-34, col. 8, lines 46-54, Fig 11 to Fig 13 lines 50-57; Bahar: see par. 0013, 0034, 0038, figures 1-5 and text related to the figures; providing notice of the email and generating the confirmation of receipt notice)." Thus it is Examiners position that the 35 U.S.C 103 (a) rejection is proper.

5. **Examiner's Note:** Examiner has cited particular paragraphs, figures, columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to UMAR CHEEMA whose telephone number is (571)270-3037. The examiner can normally be reached on M-F 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Jr. Vaughn can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Uc

/William C. Vaughn, Jr./  
Supervisory Patent Examiner, Art Unit 2144